

### REMARKS

Applicant's representative wishes to thank the Examiner for the telephonic interview of April 16, 2009. Interview participants were Examiner Dean Nguyen, and counsel for the assignee, Accenture Global Services GmbH, Daniel Ho and John Lagowski. In the interview, amendments were proposed to overcome each of the 35 USC § 101 rejections. The Examiner indicated that the proposed amendments, reflected below, would overcome all of the 35 USC § 101 rejections. No agreement was reached regarding the 35 USC §§ 102 and 103 rejections.

In the Office Action of January 12, 2009, claims 1-9 and 15-86 were rejected as follows:

- 35 USC § 101
  - Claims 1-6 and 9 were rejected under 35 USC § 101 as being apparatus claims that do not recite an apparatus or structural element
  - Claims 15-19 were rejected under 35 USC ¶ 101 as comprising a memory embodied on a computer readable media
  - Claims 83-86 were rejected under 35 USC ¶ 101 as directed at software components
  - Claims 1-9 and 15-82 were rejected under 35 USC ¶ 101 in light of In re Bilski
- 35 USC §§ 102(e) and 103(a)
  - Over Adler (U.S. Pub. 2002/0169658): Claims 1-9, 15-86

In the Office Action the Examiner referred to claim 20 as a representative claim. For consistency sake, Applicants will address the 35 USC §§ 101, 102(e) and 103(a)

rejections with respect to claim 20 at the outset, and address the remaining claims further below.

Claim 20

Claim 20, as amended provides:

A method of identifying a business organization transformation opportunity for a business that provides a product or service, comprising:

displaying on a display a first set of data fields corresponding to business organization data of the business;

receiving a plurality of business organization data inputs from a data entry terminal by a user and responsively displaying the received business organization data inputs in the first set of data fields, wherein the plurality of business organization data inputs correspond to a first state of a first business organization function of the business, and wherein the first business organization function is associated with providing the product or service;

analyzing at least one of the business organization data inputs in accordance with at least one industry threshold;

automatically modeling by a processor a business organization transformation opportunity scenario that includes a second state of the first business organization function, different than the first state, associated with providing the product or service responsive to the analysis; and

displaying on the display a user interface that includes information associated with the modeled business organization transformation opportunity scenario.

Support for the amendments is at least as follows:

- a business providing a product or service (§ 57)
- displaying on a display a first set of data fields (§§ 29 and 10)
- data entry terminal (§§ 26 and 29)
- displaying received business organization data inputs in a first set of data fields (§§ 54 and 55; FIGS. 4A-4E)

- a first state and a second state of a first business organization function (FIGS. 5 and 6; Original claims 20, 29, 47; ¶¶ 4, 40, 48, 54)
- wherein the first business organization function is associated with providing the product or service (human resources function: ¶¶ 4, 7, and 32)
- automatically modeling by a processor (system implements a transformation opportunity indicator ¶ 25; system includes a controller ¶ 26; controller may be a processor ¶ 27; generating a model ¶ 50)
- displaying information associated with the business organization transformation opportunity scenario (¶¶ 92-102)

Thus, no new matter has been added by way of the amendments.

- 35 USC § 101

Claim 20, as amended, recites statutory subject matter because the method is tied to another statutory class. Claim 20 recites that data fields are displayed on a display and that business organization data inputs are received from a data entry terminal. The business organization data inputs, received from the data entry terminal, are analyzed and a business organization transformation opportunity scenario is modeled. A processor models the business transformation opportunity scenario.

In claim 20, the plurality of business organization data inputs includes the “at least one of the business organization data inputs” that is analyzed in accordance with the industry threshold. Responsive to the analysis of the data input and the industry threshold, a business organization transformation opportunity scenario is modeled. Therefore, the display for displaying the data fields, the data entry terminal from which corresponding data inputs are received, and the processor are associated with at least the “analyzing” and “modeling” steps. Thus, the display, the data entry terminal, and the processor are all tied to significant activity of the claimed method. A display and data entry terminal are machines, which is patentable subject matter

under 35 U.S.C. §101. In light of the amendment, Applicants respectfully request that the 35 U.S.C. §101 rejection be withdrawn.

- 35 USC §§ 102(e) and 103(a)

Adler discloses a system and method for a user to model potential business strategies and provide the user with an idea of the potential outcome if a modeled strategy is implemented. In other words, a business strategy is modeled by a user (user inputs state A and state B; state A to state B is the user modeled strategy), and then a simulation is run against environmental conditions in the market and/or assumptions about elements of the modeled strategy. The output of the method of Adler is result data. Adler provides:

“Businesses need analogous capabilities to conduct virtual test drives for their strategic decisions--a means of exploring the consequences of their options in a concrete and detailed manner, prior to making significant, often irreversible capital investments and market exposures.” (Adler, ¶ 17)

Adler discloses a modeling framework that includes a domain model and scenarios. The domain model includes active agents in the decision domain, passive constructs, and environmental elements that characterize the economic backdrop. (Adler, ¶ 73) Scenario data includes: “the current market shares for businesses for particular trade items in a given market; the projected subscription rates for the charter members of a new B2B marketplace; the annual rate of inflation; and the annual rate of growth of trades within a market. Scenarios may also specify events, such as a hypothetical shortage of raw materials at some future time  $t_x$ , which may impact the economy, a market, its participating businesses, or some combination of these entities.” (Adler, ¶ 74)

Next, a set of decision options are specified by a user. (Adler, ¶ 75)

Finally, the simulation is executed and results are extracted in file-based form. Adler summarizes the process as follows:

“Using the GUT's simulation control interface, the analyst then selects the desired model, option, and scenario, which is loaded into the simulation engine 305 and executed. The event manager 303 may be used to inject events into the simulation engine 305. Results are extracted in a file-based form 306, which the analyst can import into a third-party and/or commercial spreadsheet 304 using the invention's spreadsheet add-on utility. The analyst then reviews the simulation data, via a user interface 307 that may include both predefined reports and native analytic tools of the spreadsheet 304, as required.” (Adler, ¶ 98)

Thus, Adler discloses a system and method that provides a simulation of events based on a first, current state and a pre-determined, user-defined second state of the business. For example, a pre-determined second state may be if the user's corporation (corporation A) merges with corporation B. *The first and second states are input by the user* into the system, and the system simulates, and determines result data (“For example, users can analyze the attractiveness of B2B marketplaces to new members, and study liquidity growth to help assess their relative likelihood of survival and profitability, which in turn helps users to select the most promising build, buy, join, or hybrid strategy.” ¶ 33).

In contrast, in claim 20 the second state is modeled by way of the method steps (by the processor). In other words, in Adler, the “output” is *result* data of A-to-B. In claim 20, the “output” is state B. Claim 20 recites that the modeled business organization opportunity scenario “includes a second state of the first business organization function, different than the first state.” In other words, claim 20 recites modeling a different state of a *function* associated with providing a product or service of the business organization (as defined earlier in the claim). On the other hand, Adler models outcomes (e.g., metric data) that may result due to a user-defined course of action. In Adler, **both** states of the business are input data, neither is output data. The second state is associated with a strategic decision. Adler defines strategic decisions as follows: “A decision is strategic if it defines, maintains, or changes a company's mission, market scope, and/or market differentiation.” Alder, ¶

3. Outcome data is “result” data, which is not the same as and does not correspond to data that “models” a second state of a business function.

Adler discloses build, buy, join, and extend as potential business strategies. Adler does not disclose how these or any other strategies would affect internal operations of a company, such as indicating or suggesting how human resources functions could be changed if the potential business strategy were to take place. In fact, Adler does not disclose or discuss how internal functions are implemented, either before, during, or after a business strategy is executed.

For at least these reasons, claim 20 is not anticipated by Adler.

Further, Adler is not modifiable to render claim 20 obvious. As stated above, in Adler a user enters the first and second states. The Adler system is configured to determine only potential results. Modifying Adler to determine the strategic decision would be to change Adler so that it does not function for its intended purpose. In other words, Adler discloses a system that is responsive to a user’s decision as to state B, and outputs result data. There is no support or reason articulated in Adler to have the user input only state A, and have the system determine state B. Moreover, Adler does not disclose any technology or process, or suggest any technology or process, directed at having the system determine state B. Adler is directed at providing data related to the attractiveness of executing the strategy modeled by the user (to provide the “result” data of A-to-B). In addition, only the present application discloses a system that determines the second state. Therefore, only through hindsight reconstruction in view of the present application would one contemplate modifying Adler so that it anticipates claim 20. Thus, modifying Adler so that the system/method determines state B would be modifying Adler so that it does not function for its intended purpose.

For at least these reasons, claim 20 is not obvious over Adler.

Applicants respectfully request that the rejection of claim 20 be withdrawn.

Claims 21-46

Applicants note that some of claims 21-46 have been amended to improve claim form and/or for antecedent basis reasons in light of the amendments to independent claim 20. No new matter has been added.

Claims 21-46 depend on claim 20 and are believed allowable for at least the same reasons.

In addition, claim 30 recites three types of business organization transformation opportunity scenarios that are automatically modeled: outsourcing, internally restructuring, and a mixed outsourcing/internally restructuring. In Adler, neither the strategy modeled by a user nor the result data determined by the system include any of the three scenarios defined in claim 30. Outsourcing and/or internally restructuring a business function is neither a business strategy (i.e., build, buy, join, extend, define, maintain, or change a company's mission, market scope, and/or market differentiation) nor result data (performance metrics).

As stated above for claim 20, Adler does not disclose how internal functions are implemented, either before, during, or after a business strategy is executed. Moreover, Adler does not disclose automatically modeling any one of outsourcing, internally restructuring, and mixed outsourcing/internally restructuring a business organization function.

For these additional reasons, claim 30 is believed allowable over Adler.

In addition, claim 35 recites that the first business organization function is a human resources function. In claim 20, upon which claim 35 depends, the first business organization function is defined in a first state as corresponding to a plurality of business organization data inputs. The processor automatically models a second state of the first business organization function. Thus, in claim 35 the human resources function is defined in two different states, the second state being

automatically modeled. As stated above, Alder does not automatically model states. Adler automatically provides only result data, such as performance metrics.

For these additional reasons, claim 35 is believed allowable over Adler.

Claim 37 recites several human resources sub-functions that may be automatically modeled, such as recruiting, time and attendance, and training and development. None of the sub-functions listed in claim 37 are performance metrics.

For these additional reasons, claim 37 is believed allowable over Adler.

Claim 1

• 35 USC § 101

Claim 1 is a system claim that has been amended to recite structural elements, namely a microprocessor and a display:

A system for identifying a business organization transformation opportunity for a business organization that provides a product or service, comprising:

a microprocessor configured to receive controller programmed for receiving at the system a plurality of business organization data inputs corresponding to a first state of a first business organization function of the business organization, wherein the first business organization function is associated with providing the product or service, analyzing at least one of the business organization data inputs in accordance with at least one industry threshold, and modeling a business organization transformation opportunity scenario that includes a second state of the first business organization function, different than the first state, associated with providing the product or service with respect to a particular function of the business organization responsive to the analysis;

a storage device coupled with the controller for storing at least one business organization data input received at the controller; and

a display user interface coupled to [[with]] the microprocessor to present a user interface that includes controller for receiving and presenting data and information associated with to a user of the



modeled business organization transformation opportunity scenario indicator.

Support for the amendments is at least as follows:

- see citations above for support of the functional amendments to claim 20
- a microprocessor (FIG. 1; ¶ 27)
- a display (FIG. 1; ¶ 26)

Thus, no new matter has been added. In light of the amendments that add structural elements, Applicants respectfully request that the 35 U.S.C. §101 rejection be withdrawn.

- 35 USC §§ 102(e) and 103(a)

As amended, claim 1 includes, in apparatus form, the features discussed above in claim 20 for distinguishing over Adler. For example, claim 1 recites:

A microprocessor configured to receive a plurality of business organization data inputs corresponding to a first state of a first business organization function of the business organization, wherein the first business organization function is associated with providing the product or service, analyzing at least one of the business organization data inputs in accordance with at least one industry threshold, and modeling a business organization transformation opportunity scenario that includes a second state of the first business organization function, different than the first state, associated with providing the product or service responsive to the analysis

\* \* \*

In Adler, a user enters the first and second states, and the system/method provides simulation results. The system of Adler does not provide the second state based on the first state and an industry threshold, as claimed. Also, modifying Adler to determine the strategic decision would be to change Adler so that it does not function for its intended purpose.

For at least these reasons, claim 1 is not anticipated by or obvious over Adler.

Applicants respectfully request that the rejection of claim 1 be withdrawn.

#### Claims 2-9

Applicants note that some of claims 2-9 have been amended to improve claim form and/or for antecedent basis reasons in light of the amendments to claim 1. No new matter has been added.

Claims 2-9 depend on claim 1 and are believed allowable for at least the same reasons.

In addition, claim 2 recites that the first business organization function is a human resources function. For the reasons stated above for claim 35, claim 2 is believed allowable.

Claim 3 recites three types of business organization transformation opportunity scenarios. For the reasons stated above for claim 30, claim 3 is believed allowable.

#### Claim 15

- 35 USC § 101

Claim 15 was rejected as directed at a memory embodied on a computer readable media for use on a suitable processor. Claim 15 has been amended to more clearly recite that the media is a storage media ("A computer readable storage media having processor executable instructions to . . .").

Support for the amendment is at least as follows:

- ¶¶ 28, 30, and 31

No new matter has been added.

Claims 15 and dependent claims 16-19 are thus Beauregard claims that recite a computer readable storage media. Post In re Bilski, the Board of Patent Appeals and

Interferences has held that Beauregard claims are still considered patentable subject matter. (Ex parte Bo Li, Appeal 2008-1213, Application 10/463,287, Decided November 6, 2008). Accordingly, Applicants respectfully request that the 35 USC § 101 rejections of claims 15-19 be withdrawn.

- 35 USC §§ 102(e) and 103(a)

As amended, claim 15 includes, in Beauregard form, the features discussed above in claim 20 for distinguishing over Adler. For example, claim 15 recites:

\* \* \*

model a business organization transformation opportunity scenario that includes a second state of the first business organization function, different than the first state, associated with providing the product or service responsive to the analysis.

For the reasons stated above for claims 1 and 20, claim 15 is believed not anticipated by or obvious over Adler.

Applicants respectfully request that the rejections of claim 15 be withdrawn.

#### Claims 16-19

Applicants note that claims 16-19 have been amended to improve claim form and/or for antecedent basis reasons in light of the amendments to claim 15. No new matter has been added.

Claims 16-19 depend on claim 15 and are believed allowable for at least the same reasons.

In addition, claim 16 recites that the first business organization function is a human resources function. For the reasons stated above for claim 35, claim 16 is believed allowable.

Claim 17 recites three types of business organization transformation opportunity scenarios. For the reasons stated above for claim 30, claim 17 is believed allowable.

Claim 47

- 35 USC §§ 101, 102(e), and 103(a)

Claim 47 was rejected as a method claim in light of *In re Bilski*.

Claim 47 has been amended to the format of a Beauregard claim. For the reasons stated above for claim 15, amended claim 47 is supported by the specification, does not include new matter, is directed at patentable subject matter, and is not anticipated by or obvious over Adler. For example, amended claim 47 recites:

A computer readable storage media having processor executable instructions to:

receive a plurality of business organization data inputs corresponding to a first state of a first business organization function of a business organization that provides a product or service;

\* \* \*

model a business organization transformation opportunity scenario that includes a second state of the first business organization function, different than the first state, associated with providing the product or service responsive to the analysis.

Accordingly, Applicants respectfully request that the rejections of claim 47 be withdrawn.

Claims 48-61

Applicants note that claims 48-61 have been amended to improve claim form and/or for antecedent basis reasons in light of the amendments to claim 47. No new matter has been added.

Claims 48-61 depend on claim 47 and are believed allowable for at least the same reasons.

In addition, claim 50 recites three types of business organization transformation opportunity scenarios. For the reasons stated above for claim 30, claim 50 is believed allowable.

Claim 55 recites that the first business organization function is a human resources function. For the reasons stated above for claim 35, claim 55 is believed allowable.

Claim 57 recites several human resources sub-functions that may be automatically modeled, such as recruiting, time and attendance, and training and development. None of the sub-functions listed in claim 57 are performance metrics. For these additional reasons, claim 57 is believed allowable over Adler.

Claim 62

- 35 USC §§ 101, 102(e) and 103(a)

Claim 62 was rejected as a method claim in light of *In re Bilski*.

Claim 62 has been amended to the format of a Beauregard claim. For the reasons stated above for claim 47, amended claim 62 is supported by the specification, does not include new matter, is directed at patentable subject matter, and is not anticipated by or obvious over Adler. For example, amended claim 62 recites:

A computer readable storage media having processor executable instructions to:

\* \* \*

model a business organization transformation opportunity scenario with respect to a particular function of the business organization responsive to the analysis, wherein the business organization transformation scenario includes transforming a first state of the particular function to a second state of the particular function, and wherein the particular function is associated with providing a product or service of a business organization.

Accordingly, Applicants respectfully request that the rejections of claim 62 be withdrawn.

Claims 63-82

Applicants note that claims 63-82 have been amended to improve claim form and/or for antecedent basis reasons in light of the amendments to claim 62. No new matter has been added.

Claims 63-82 depend on claim 62 and are believed allowable for at least the same reasons.

In addition, claim 71 recites three types of business organization transformation opportunity scenarios. For the reasons stated above for claim 30, claim 71 is believed allowable.

Claim 76 recites that the first business organization function is a human resources function. For the reasons stated above for claim 35, claim 76 is believed allowable.

Claim 83

- 35 USC §§ 101, 102(e) and 103(a)

Claim 83 was rejected as directed to non-statutory subject matter.

Claim 83 has been amended to the format of a Beauregard claim. For the reasons stated above for claims 47 and 61, amended claim 83 is supported by the specification, does not include new matter, is directed at patentable subject matter, and is not anticipated by or obvious over Adler.

Accordingly, Applicants respectfully request that the rejections of claim 83 be withdrawn.

Claims 84 and 85

Applicants note that claims 84 and 85 have been amended to improve claim form and/or for antecedent basis reasons in light of the amendments to claim 83. No new matter has been added.

Claims 84 and 85 depend on claim 83 and are believed allowable for at least the same reasons.

In addition, claim 84 recites that the modeled transformation scenario is a human resources transformation scenario. For the reasons stated above for claim 35, claim 84 is believed allowable.

Claim 85 recites three types of business organization transformation opportunity scenarios. For the reasons stated above for claim 30, claim 85 is believed allowable.

Conclusion

Therefore, in view of the above remarks, we respectfully submit that this application is in condition for allowance and such action is earnestly requested.

If for any reason the Examiner is not able to allow the application, he is requested to contact the Applicants' undersigned attorney at (312) 321-4200.

Respectfully submitted,

/John R. Lagowski/  
John R. Lagowski  
Registration No. 41,922  
Attorney for Applicant

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200